



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|---------------------------|-----------------------|------------------|
| 09/883,619 | 06/18/2001 | Robert Martin Wynalda JR. | 1949-A-CIP | 5116 |
| 45069 | 7590 | 12/04/2006 | EXAMINER | |
| FRED ZOLLINGER III P.O. BOX 2368 NORTH CANTON, OH 44720 | | | CHEVALIER, ALICIA ANN | |
| | | | ART UNIT | PAPER NUMBER |

1772

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

C

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/883,619 | WYNALDA ET AL. | |
| | Examiner | Art Unit | |
| | Alicia Chevalier | 1772 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-15,23 and 26-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-15,23 and 26-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMENDMENT

1. Claims 7-15, 23 and 26-35 are pending in the application, claims 1-6, 16-22, 24 and 25 have been cancelled.

WITHDRAWN REJECTIONS

2. The 35 U.S.C. §102 rejection of claim 35 over Brinkhurst (GB 2 274 452 A), made of record in the office action mailed April 3, 2006, pages 2-3, paragraph #4 has been withdrawn due to Applicant's argument in the pre-appeal conference request filed August 3, 2006 and the numerous 35 U.S.C. §112, first and second rejections.

3. The 35 U.S.C. §103 rejection of claim 7 as over Brinkhurst (GB 2 274 452 A) in view of McKowen (US Patent No. 3,244,436), made of record in the office action mailed April 3, 2006, pages 3-4, paragraph #6 has been withdrawn due to Applicant's argument in the pre-appeal conference request filed August 3, 2006 and the numerous 35 U.S.C. §112, first and second rejections.

4. The 35 U.S.C. §103 rejection of claims 8 and 9 as over Brinkhurst (GB 2 274 452 A) in view of McKowen (US Patent No. 3,244,436) and Youngs (US Patent No. 4,850,731), made of record in the office action mailed April 3, 2006, page 5, paragraph #7 has been withdrawn due to Applicant's argument in the pre-appeal conference request filed August 3, 2006 and the numerous 35 U.S.C. §112, first and second rejections.

5. The 35 U.S.C. §103 rejection of claims 10 and 11 as over Brinkhurst (GB 2 274 452 A) in view of McKowen (US Patent No. 3,244,436) and Udwin et al. (US Patent No. 6,106,015),

Art Unit: 1772

made of record in the office action mailed April 3, 2006, pages 5-6, paragraph #8 has been withdrawn due to Applicant's argument in the pre-appeal conference request filed August 3, 2006 and the numerous 35 U.S.C. §112, first and second rejections.

6. The 35 U.S.C. §103 rejection of claims 12-15 as over Brinkhurst (GB 2 274 452 A) in view of McKowen (US Patent No. 3,244,436) and Gelardi (US Patent No. 5,799,782), made of record in the office action mailed April 3, 2006, page 6, paragraph #9 has been withdrawn due to Applicant's argument in the pre-appeal conference request filed August 3, 2006 and the numerous 35 U.S.C. §112, first and second rejections.

7. The 35 U.S.C. §103 rejection of claims 23 and 26-33 as over Brinkhurst (GB 2 274 452 A) in view of Gelardi (US Patent No. 5,799,782), made of record in the office action mailed April 3, 2006, pages 6-8, paragraph #10 has been withdrawn due to Applicant's argument in the pre-appeal conference request filed August 3, 2006 and the numerous 35 U.S.C. §112, first and second rejections.

8. The 35 U.S.C. §103 rejection of claim 34 as over Brinkhurst (GB 2 274 452 A) in view of Gelardi (US Patent No. 5,799,782) and Udwin et al. (US Patent No. 6,106,015), made of record in the office action mailed April 3, 2006, page 8, paragraph #11 has been withdrawn due to Applicant's argument in the pre-appeal conference request filed August 3, 2006 and the numerous 35 U.S.C. §112, first and second rejections.

REJECTIONS

9. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 112

10. Claims 7-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case claim 7 contains the limitation “the V-shaped edge being indented into the page to define the pocket for the adhesive.” The examiner is unable to find support for this limitation in the specification. The only discussion in the specification regarding “indenting” relates to indentations in the cover to create hinges (*page 6, lines 3-7 and page 5, lines 5-8*).

The new matter should be deleted.

11. Claims 23, 26-29 and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case claims 27 and 35 contain the limitation “the first and second halves having been separately formed and ***non-pivotably joined together*** to from the substantially rigid plastic page.” The examiner is unable to find support for this limitation in the specification.

The new matter should be deleted.

12. Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described

Art Unit: 1772

in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case claim 23 contain(s) the limitation “wherein the front and rear covers are free of connections to any pages.” The specification does not disclose that the covers are excluded from being connected to the pages. The specification explicitly teaches that the covers are connected to the pages via the spine, therefore this limitation is considered new matter. See page 3, lines 3-5 “a substantially rigid disc-holding page connected to a cover member along the spine of the cover member so that the container may be open and closed like a book.”

Any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. MPEP § 2173.05(i)

The new matter should be deleted.

13. Claims 23, 26-29 and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case claims 27 and 35 contain the limitation “a substantially rigid plastic page.” The examiner is unable to find support for the pages being made of plastic in the specification. The examiner is unable to find any recitation in the specification regarding the materials used for the pages. The only disclosure of plastic in the whole specification is on page 6, lines 13-14, where it recites “cover 20 may be fabricated from a thin plastic material.”

The new matter should be deleted.

Art Unit: 1772

14. Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case claim 29 contain(s) the limitation “the literature card is non-removably disposed between the first and second halves.” The specification does not disclose that the literature card is excluded from being removed from the page halves, therefore this limitation is considered new matter.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), aff'd mem., 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. MPEP § 2173.05(i)

The new matter should be deleted.

15. Claims 30-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case claim 30 contain the limitation “a plastic page.” The examiner is unable to find support for the pages being made of plastic in the specification. The examiner is unable to find any recitation in the specification regarding the materials used for the pages. The only disclosure of plastic in the whole specification is on page 6, lines 13-14, where is recites “cover 20 may be fabricated from a thin plastic material.”

The new matter should be deleted.

Art Unit: 1772

16. Claims 30-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case claim 30 contain(s) the limitation "the page being free of connections with the front and rear covers." The specification does not disclose that the covers are excluded from connected to the pages. The specification explicitly teaches that the covers are connected to the pages via the spine, therefore this limitation is considered new matter. See page 3, lines 3-5 "a substantially rigid disc-holding page connected to a cover member along the spine of the cover member so that the container may be open and closed like a book."

Any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. MPEP § 2173.05(i)

The new matter should be deleted.

17. Claim 33 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case claim 33 contain(s) the limitation "the literature card is non-removably disposed between the first and second halves." The specification does not disclose that the literature card is excluded from being removed from the page halves, therefore this limitation is considered new matter.

Art Unit: 1772

Any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. MPEP § 2173.05(i)

The new matter should be deleted.

18. Claims 7-15, 23 and 26-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites "*a* page" in line 5 and "*each* page" in lines 11-13. It is unclear how many pages are being claimed, since "*a*" refers to a single item and "*each*" refers to two or more.

Claim 7 recites the limitation "the V-shaped edge" in line 16. There is insufficient antecedent basis for this limitation in the claim. Before line 16 Applicant introduces a page edge and a V-shaped cross section of a pocket between the page edge and cover. Therefore, there is no basis for "the V-shaped edge."

Claim 7 recites "the V-shaped edge being indented into the page" which is unclear and renders the claim vague and indefinite. It is unclear how the "page edge" is being indented. Is Applicant claiming that the edge of the page has a V-shape as well as a V shape pocket connection to the cover.

Claim 9 recites "each locking finger is disposed in a pocket" which is unclear and renders the claim vague and indefinite. It is unclear where the pockets are located. It is assumed that the pockets are on the page half and not an extra layer as described in the specification on page 8, lines 6-7 and in figure 5.

Art Unit: 1772

Claim 12 recites “a literature card disposed between the page halves” which is unclear and renders the claims vague and indefinite. It is unclear how a literature card is disposed between the halves if there is no gap/space claimed between the halves to accommodate the card.

Claim 23 recites “wherein the front and rear covers are free of connections to any pages” is unclear and renders the claim vague and indefinite. It is unclear what “connections” the covers are free from the pages. Also, if the pages are not connected to the cover at all how does the container stay together. Furthermore, this limitation is completely contradictory to the specification. See page 3, lines 3-5 “a substantially rigid disc-holding page connected to a cover member along the spine of the cover member so that the container may be open and closed like a book.”

Claim 26 recites “the page is entirely disposed between the front and rear covers when the covers are in the closed position” which is unclear. It is unclear what applicant means by “entirely”, specifically is Applicant trying to claim more than that the page is between the front and rear cover?

Claim 27 recites “a literature card being disposed between within the page” which is unclear and renders the claims vague and indefinite. It is unclear how a literature card is disposed between the halves if there is no gap/space claimed between the halves to accommodate the card.

Claim 30 recites “the page being free of connections with the front and rear covers” is unclear and renders the claim vague and indefinite. It is unclear what “connections” the covers are free from the pages. Also, if the pages are not connected to the cover at all how does the container stay together. Furthermore, this limitation is completely contradictory to the

Art Unit: 1772

specification. See page 3, lines 3-5 “a substantially rigid disc-holding page connected to a cover member along the spine of the cover member so that the container may be open and closed like a book.”

ANSWERS TO APPLICANT’S ARGUMENTS

19. Applicant’s arguments in the pre-appeal conference request filed August 3, 2006 regarding the 35 U.S.C. §102 and §103 rejections previously of record have been considered but are moot since the rejections have been withdrawn.

20. Applicant’s arguments in the pre-appeal conference request filed August 3, 2006 regarding the 35 U.S.C. §112, first paragraph, rejection of claims 7-15 regarding the limitation “the V-shaped edge being indented into the page to define the pocket for the adhesive”, of record have been carefully considered but are deemed unpersuasive.

Applicant argues that the V-shaped edge that is indented into the page currently recited in claim 7 is described in the specification on page 9, lines 10-16 and depicted in figures 7-10.

Applicant further argues that Page 9, lines 10-16 recites:

Each page 22 is connected to cover 20 along one edge 70 of page 22 so that cover 20 will act like the cover of a book. When page 22 is symmetric, page 22 will have two edges 70 that will allow for connection to spine 28. In one embodiment of the invention, edge 70 is connected to spine 28 with an adhesive 72. Edge 70 may be somewhat V-shaped in cross section (see Fig. 7) to provide a pocket to hold adhesive 72. The walls of the pocket may have a slight draft such as 2 percent with the drawings exaggerating the draft for clarity.

This section of the specification does not disclose that the page is indented, rather that the connection between the edge of the page and the cover is somewhat V-shaped in cross section to provide a pocket to hold adhesive. Furthermore, figures 7-10 support the concept that the page is

Art Unit: 1772

not indented with a V-shape. Rather the connection point between the page edge and cover is somewhat V-shaped.

21. Applicant's arguments in the pre-appeal conference request filed August 3, 2006 regarding the 35 U.S.C. §112, first paragraph, rejection of claims 23, 26-29 and 35 regarding the limitation "the first and second halves having been separately formed and *non-pivotably joined together* to form the substantially rigid plastic page", of record have been carefully considered but are deemed unpersuasive.

Applicant argues that the recitation of the "non-pivotable connection between the page halves" is not new matter. Applicant contends that support for this limitation can be found on page 7, line 18 through page 8, line 16. Applicant concludes that there is no requirement that the exact words of the claims be found in the written description. MPEP 2163.02.

While the examiner does agree with Applicant that there is no requirement that the exact words of the claims be found in the written description, there is a requirement that the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed. MPEP 2163.02.

Page 7, line 18 through page 8, line 16 of the instant specification recites:

In this configuration, page 22 is formed from two page halves 44 that are connected together in a back-to-back arrangement so that the two discs are accessible from opposite sides of page 22.

Halves 44 may be connected together in any of a wide variety of different manners. Halves 44 may be formed with locking fingers 46 that snap fit onto ledges defined at the edge of openings 50. Each locking finger 46 has an angled upper surface that engages the other half 44 to bend the finger outwardly to allow finger 46 to deflect through opening 50. Each half 44 may be formed with two fingers 46 disposed at opposite corners so that a locking finger 46 snaps onto a ledge 48 at all four corners of page 22 when the halves 44 are snapped together. Fingers 46 may be disposed in pockets 52 defined by pocket walls 54 to protect the connection between fingers 46 and ledges 48.

Other ways of connecting halves 44 are depicted in Figs. 5B and 5C. In Fig. 5B, adhesive 56 is used to connect halves 44. In Fig. 5C, halves 44 are welded together with a weld 60. Other manners of connecting halves 44 may be used without departing from the concept of the present invention.

Art Unit: 1772

Each half 44 includes a perimeter sidewall having thickness sufficient to protect the item of recorded media held on page half 44. The perimeter sidewalls of halves 44 cooperate together to form a perimeter sidewall for page 22. The sidewalls of pages 22 abut one another to provide rigidity to container 10 when all pages 22 and cover 20 are closed.

This passage discloses several specific ways of putting the two halves together but doesn't say anything about the pivoting nature of the halves. The limitation "the first and second halves having been separately formed and *non-pivotably joined together* to form the substantially rigid plastic page" is different in scope than what is disclosed in the specification regarding the formation of the first and second halves. Therefore, the limitation "non-pivotally joined together" is new matter because one of ordinary skill in the art would not have recognized that Applicant had invented what is claimed in view of the specification.

As the examiner has noted that Applicant has better language in the specification to describe their pages. Specifically, each page is formed from two page halves that are connected together in a back to back arrangement so that two discs are accessible from opposite sides of each page; each page half includes a perimeter sidewall having a thickness to protect the disc held on the page half and the perimeter sidewalls of each half cooperate together to form a perimeter sidewall for each page; each page half defines a rear surface having planar portions that abut each other when the halves are connected together and the planar portions comprise a literature card disposed between the page halves (page 7, lines 16-20 and page 8 lines 12-22).

Conclusion

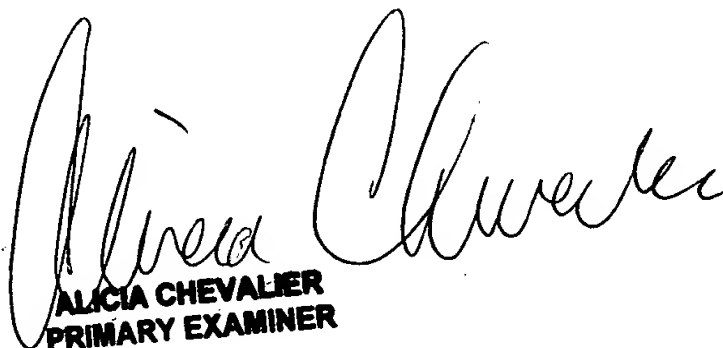
22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

Art Unit: 1772

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac
11/27/06


ALICIA CHEVALIER
PRIMARY EXAMINER